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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,722	12/28/2001	Lester Benjamin Johnson	87354.1581	4118
30734 7590 07/05/2007 BAKER & HOSTETLER LLP WASHINGTON SQUARE, SUITE 1100 1050 CONNECTICUT AVE. N.W. WASHINGTON, DC 20036-5304			EXAMINER RUHL, DENNIS WILLIAM	
			ART UNIT 3629	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/028,722	Applicant(s) JOHNSON ET AL.	
	Examiner Dennis Ruhl	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,10,11 and 15-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/19/07 has been entered.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 11,24,28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11,24,28 include method steps that are using the structure recited of the same apparatus claim. This is improper because these claims then appear to be directed to both an apparatus and the method of using that apparatus. Claims must fall into only one statutory class of invention at one time to be considered statutory. These claims are mixing two different statutory classes of invention, which renders them as non-statutory. Claim 11 recites, "a data input wherein vehicle diagnostic data *is inputted into the system* through a connection with a vehicle diagnostic equipment". This is a method step directed to using recited structure in what is an apparatus type of claim. Claim 24 recites, "the means for displaying *indicates if* the at least one service solution

is covered under the warranty". This also appears to be a method step. Claim 28 recites "outputs to a display".

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1,5,11,15-20,23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1, it is not clear if the scope of the claim includes any "data" as being displayed, or if the data being displayed is actually the "service solution and warranty information". The claim language of "*displaying data as a result of the comparison, the at least one service solution and warranty information.*" is indefinite. This language does not make it clear what is being displayed. Is it just "data" or the "service solution and warranty information"? This is not clear.

For claim 20, it has not been claimed that the warranty information is being displayed, because the claim seems to be open to just any type of data being displayed. This claim is indefinite for the same reason as stated above for claim 6. Is the display of warranty data actually claimed? This is not clear.

For claim 23, it is not clear if the scope of the claim includes the diagnostic equipment or not. The language of claim 6 only recites the diagnostic equipment as the source of data for the "means for receiving". This is not the same as claiming the diagnostic equipment as part of the claimed system. Now in claim 23, it is claimed that

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there is a direct link between the diagnostic equipment and the “means for receiving”. It is not clear if the diagnostic equipment is being claimed as part of the invention. Claim 6 does not positively recite this element but claim 23 refers to it like it is a claimed element. Correction is required.

For claims 11,24,28, one wishing to avoid infringement would not know if infringement would occur by just having the claimed system or would infringe by having the claimed system and actually using it in the claimed manner. Claim 11 recites, “a data input wherein vehicle diagnostic data *is inputted into the system* through a connection with a vehicle diagnostic equipment”. This is a method step directed to using recited structure in what is an apparatus type of claim. Claim 24 recites, “the means for displaying *indicates if* the at least one service solution is covered under the warranty”. This also appears to be a method step. Are the method steps required for infringement or is just the structure of the system required for infringement? This is not clear. Claim 28 recites “outputs to a display”.

For claims 25,29, what is applicant claiming by reciting that the claimed “system” is “contained on a computing device”? What is being claimed? Claims 6,11 are directed to just the system. Now claims 25,29, are reciting that the system is on a computing device? This is a claim directed to the system of the independent claim and a computing device, which is a combination claim, whereas the independent claim is a subcombination claim. The scope of these claims is not clear. How can the system be claimed as being on a computing device, especially when dependent claims are by definition supposed to be further limiting to the claimed invention of the independent

claim. That means that claim 25 and 29 should be further defining something about the claimed system, which it is not. These claims are indefinite.

For claim 29, how can applicant claim that the system (which is made up of the databases, data input, microprocessor) includes the databases, data input, microprocessor, in being contained in a computing device? This makes no sense. The system itself is made up of the other elements that applicant has claimed are all contained in a computing device. If the system is not the same as the recited elements of claim 11, then what is the system of claim 29? This is not clear.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 6,10,11,15,21,22,24-29, are rejected under 35 U.S.C. 102(e) as being anticipated by Li ((20020072808).

For claim 6, applicant should take notice that the language of “*means for receiving vehicle diagnostic information into the system* from a vehicle diagnostic system” has been considered only to the extent that this is claiming a “means for receiving” information by the system. The same is true for claim 11 and the language about the “data input” and where it comes from. The source of that information (i.e.

where it comes from) is not part of the claim scope. Claims 6 and 11 are apparatus claims and structure is what is covered by means plus function language. In this case, this language is covering the disclosed structure and their equivalents that allows for the receipt of diagnostic data to occur, or just a data input for claim 11. The fact that the data is intended to come from "diagnostic equipment" is not a limitation that requires any diagnostic equipment at all in the scope of the claim. The language "from a vehicle diagnostic system" is directed to the intended source of the data and has nothing to do with the structure that is covered by the language "*means for receiving vehicle diagnostic information into the system*". Claim 6 has been examined with this interpretation in mind for this believed to be proper 102 rejection; however, the examiner has also given more weight to this language and addressed this limitation in a 103 rejection, for a more complete examination and so that applicant can be informed of what the position of the examiner is, even if the diagnostic equipment was claimed as part of the scope of the claim.

For claims 6,11,24,25,28,29, Li discloses a system and method for providing vehicle information to be used in servicing a vehicle. Li discloses a system where a user (vehicle owner or automotive service associate) can enter information concerning a given vehicle and the system can then analyze that information to give a diagnosis of what may be wrong with the vehicle. A service solution is determined based on this comparison. The system also can determine the warranty status of the vehicle based on the diagnosis of the problem (is problem covered under warranty, yes or no, see figure 11 of Li). See figure 17 and paragraph 61 where it is disclosed that vehicle

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identification information is entered. The *"means for entering the vehicle identification information"* is satisfied by the computer interface 80 that allows entry of the claimed type of data. Figure 17 shows the VIN number being entered, which identifies the vehicle. The vehicle problem information entered into the system by the user is the claimed diagnostic information, which is analyzed to arrive at a service solution. With respect to the structure that is defined by *"means for receiving vehicle diagnostic information into the system"* (data input, cl. 11), this is satisfied by the dialog manager 20 and the user input devices disclosed by Li that allow for the entry of and receipt of diagnostic data into the system. The recitation that the data is to be "from a vehicle diagnostic system" is noted, but is not seen as further specifying any particular structure to the *"means for receiving vehicle diagnostic information into the system"*. The claiming of the source of the information does not change the scope of the structure that is covered by this means language. See paragraph 42 for a disclosure of comparing the received diagnostic information to a symptoms database 90 to determine a prognosis. The *"means for comparing"* the received diagnostic information with reference information is module 30, that compares received vehicle diagnostic information to a symptoms database to determine a prognosis. This module 30 also satisfied the claimed *"means for identifying at least one service solution"*. The results are then displayed as claimed, which also satisfies the claimed *"means for displaying"*, which is just a display. Li discloses a "means for displaying" as claimed. Databases are used to store the data (for claim 11). Also, see paragraph 45 where it is disclosed that there is a warranty module 41 that identifies warranty solutions, this satisfies the

claimed "*means for determining if the at least one service solution is covered under warranty*".

For claims 10,15, the vehicle identification data itself is not a structural part of the system being claimed, so this limitation receives minimal patentable weight. Li satisfies what is claimed because Li discloses structure that satisfies the claimed "*means for entering vehicle identification information into the system*". The actual kind of data that is entered into the "*means for entering vehicle identification information into the system*" does not define any further structure to the "*means for entering*" that is claimed.

For claims 21,22,26,27, the type of diagnostic equipment claimed is not further defining the subject matter of claim 6. Li satisfies what is claimed because Li discloses a "*means for receiving vehicle diagnostic information into the system*". The diagnostic equipment is not a claimed element in the scope of claim 6, so these claims require nothing more than what is claimed in claim 6.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under

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37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (20020072808).

For claims 16,17, not disclosed is that Li is configured to receive information (diagnostic and vehicle identification information) wirelessly. Li discloses in paragraph 40 that various communication networks can be used, "or other networking technologies" (i.e. LANs, WANs, global networks). Wireless transmission of information is something that is old and well known in the art. One of ordinary skill in the art would certainly be aware of the fact that there are wireless networks in existence where data can be transferred wirelessly. This is something that one of ordinary skill in the art would be aware of as of the effective filing date for this application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Li with wireless data communication ability, so that the data could be transferred by wireless communication, as is well known in the art.

For claims 18,19, not disclosed is that the data input is configured to use the TCP/IP protocol. The TCP/IP protocol is something that is well known to one of ordinary skill in the art. This type of data transfer protocol was developed many years ago and is something that one of ordinary skill in the art would be very aware of. It

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would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the data input of Li with the TCP/IP protocol. In view of the fact that in Li a user can interact with the system from home via computer, one of ordinary skill in the art would recognize that the TCP/IP protocol would be desirable, especially because this kind of protocol is used extensively for the Internet.

8. Claims 1,5,6,10,11,15-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (20020072808) in view of Kirkevold et al. (6263322).

For claims 1,6,11,20,21,23-26,28,29, Li discloses a system and method for providing vehicle information. Li discloses a system where a user (vehicle owner or automotive service associate) can enter information concerning a given vehicle and the system can then analyze that information to give a diagnosis of what may be wrong with the vehicle. A service solution is determined as claimed. The system also can determine the warranty status of the vehicle based on the diagnosis of the problem (is problem covered under warranty, yes or no, see figure 11 of Li). See figure 17 and paragraph 61 where it is disclosed that vehicle identification information is entered. The "means for entering the vehicle identification information" is satisfied by the computer interface 80 that allows entry of the claimed type of data. Figure 17 shows the VIN number being entered, which identifies the vehicle. The vehicle problem information entered into the system by the user is the claimed diagnostic information, which is analyzed to arrive at a service solution. See paragraph 42 for a disclosure of comparing the received diagnostic information to a symptoms database 90 to determine a

prognosis. The “means for comparing” the received diagnostic information with reference information is module 30, that compares received vehicle diagnostic information to a symptoms database to determine a prognosis. This module 30 also satisfied the claimed “means for identifying at least one service solution. The results are then displayed as claimed, which also satisfies the claimed “means for displaying”, which is just a display. Databases are used to store the data (for claim 11). Also, see paragraph 45 where it is disclosed that there is a warranty module 41 that identifies warranty solutions, this satisfies the claimed “*means for identifying if the at least one service solution is covered under warranty*”.

Not disclosed by Li is that the diagnostic information is received “*directly from diagnostic equipment*”. In Li the data is entered manually and applicant is claiming a situation that is representative of an automated collection of vehicle diagnostic data.

Kirkevold discloses an auto repair shop computer system that manages just about every aspect of a repair shop that one can think of. It is specifically disclosed that the computer system includes diagnostic equipment (see figure 1, #1,12,14,16) that analyzes data taken from vehicles to diagnose a problem. For example see column 9, line 56 to column 10, line 18. Kirkevold is disclosing the fact that is it well known in the auto repair art to take vehicle data directly from vehicle analyzer components 52, that are connected to a vehicle by the repair technician. In Kirkevold, the diagnostic data that is used to diagnose the vehicle problem comes directly from diagnostic equipment that is connected to the vehicles (see figure 1). Also, the examiner notes that Kirkevold recognizes that Diagnostic Trouble Codes can be retrieved from the on board computer

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of a vehicle, see column 11, lines 49-51. The on board computer satisfies an onboard monitoring system as is claimed in claim 21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Li so that data concerning vehicle problems can be received directly from diagnostic equipment, as is taught by Kirkevold. This is very well known to one of ordinary skill in the art. The receipt of data directly from diagnostic equipment would be desirable because it allows for more complex troubleshooting to occur, such as the obtaining of data by the various devices disclosed by Kirkevold (engine analyzer, alignment analyzer, brakes analyzer, etc.) that allow for more complex problem analysis than the system of Li can provide with just user objective input. One would use diagnostic equipment connected to the vehicle, like the disclosed engine analyzer of Kirkevold. One could also connect to the vehicle's on board computer to obtain error codes (as is disclosed by Kirkevold) and this would then allow a problem diagnosis to occur based on the received data. One of ordinary skill in the art would have found it obvious to collect the diagnostic data directly from diagnostic equipment.

For claims 5,10,15, not disclosed is that the entered vehicle identification information is the make, model, and year of the car. In Li, it is disclosed that the VIN (vehicle identification number) is entered. The VIN number represents the make, model, year, and options that the vehicle has. One of ordinary skill in the art would readily appreciate this fact and would have found it obvious to have the vehicle identification information that is entered be the make, model, and year, as claimed. Li discloses the entering of vehicle ID data and modifying Li to accept the make, model,

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and year, as opposed to the VIN number, is something that one of ordinary skill in the art would have found obvious.

For claims 22,27, Kirkevold discloses the use of hand held diagnostic equipment, such as equipment 5 and 6 as shown in figure 1. the 103 combination also includes these features as being provided to Li. The 103 combination is providing Li with the ability to collect data from the various devices disclosed by Kirkevold.

For claims 16,17, not disclosed is that Li is configured to receive information (diagnostic and vehicle identification information) wirelessly. Li discloses in paragraph 40 that various communication networks can be used, "or other networking technologies" (i.e. LANs, WANs, global networks). Wireless transmission of information is something that is old and well known in the art. One of ordinary skill in the art would certainly be aware of the fact that there are wireless networks in existence where data can be transferred wirelessly. This is something that one of ordinary skill in the art would be aware of as of the effective filing date for this application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Li with wireless data communication ability, so that the data could be transferred by wireless communication, as is well known in the art.

For claims 18,19, not disclosed is that the data input is configured to use the TCP/IP protocol. The TCP/IP protocol is something that is well known to one of ordinary skill in the art. This type of data transfer protocol was developed many years ago and is something that one of ordinary skill in the art would be very aware of. It would have been obvious to one of ordinary skill in the art at the time the invention was

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made to provide the data input of Li with the TCP/IP protocol. In view of the fact that in Li a user can interact with the system from home via computer, one of ordinary skill in the art would recognize that the TCP/IP protocol would be desirable, especially because this kind of protocol is used extensively for the Internet.

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The applicant is referred to the new grounds of rejection for the position of the examiner. The newly added claim language which has been relied upon for patentability has been addressed by the examiner in the body of the rejection. The examiner believes that no further comments are necessary at this time because the position of the examiner is clearly stated in the rejections of record, which is believed to address applicant's arguments for patentability.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. Ruhl', with a long horizontal flourish extending to the right.

DENNIS RUHL
PRIMARY EXAMINER